

## REMARKS

Claims 10-43, 45-67, 246-253, 260-263, and 278-281, are presented for examination.

### Oath/Declaration

The reissue oath/declaration, attached as **Appendix A**, is alleged to be defective because it fails to identify at least one error which is relied upon to support the reissue application, and also because it fails to contain a statement that all errors, which are being corrected in the reissue application, up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the Applicants.

The unassigned oath/declaration originally filed as part of the present application, as well as the executed oath/declaration filed in response to the Notice to File Missing Parts of Application mailed November 8, 2001, satisfy the above requirements of 37 C.F.R. § 1.175. To this end, the Applicants enclose a copy of the executed oath/declaration wherein the appropriate paragraph has been highlighted.

The present application also stands objected to under 37 C.F.R. § 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent.

To address this objection, the Applicants enclose together with this response the following:

- 1) a Consent of Assignee to Reissue;
- 2) Certification under 37 C.F.R. § 3.73; and
- 3) Reissue Application by the Assignee, offer to Surrender Patent (executed by Assignee).

In light of the above, the Applicants respectfully request that the objections to the oath/declaration, and to the lack of written consent of all Assignees be withdrawn.

#### **Objection Related to Reissues Formalities**

While the Applicants believe the amendment filed October 6, 2000, to add new claims 246-357 to the reissue application did present the entire text of these claims in compliance with 37 C.F.R. § 1.173, the Applicants note that the preliminary amendment filed April 13, 2001, did not present the full text of the remaining claims. To this end, the Applicants have attached as **Appendix B** a copy showing the full text of claims 10-67, 246-253, 260-263, and 278-281 as remaining following the cancellation of the other claims by way of the preliminary amendment filed April 13, 2001.

#### **Claim Rejections – 35 U.S.C. § 251**

Claims 10-43, 45-67, 246-253, 260-263, and 278-281 stand rejected as being based on a defective reissue declaration under 35 U.S.C. § 251. As set forth above, the reissue declaration does in fact comply with 37 C.F.R. § 1.175.

#### **Specification**

The Examiner correctly noted that the specification did not contain any title headings identifying the various sections of the specification. The Applicants have, as indicated herein, accordingly amended the specification to include the appropriate title headings.

The disclosure was also objected to as failing to disclose data entries with respect to the divisional reissue applications that have been filed by the Applicants. The specification has again been amended, as indicated herein, to reference the various reissue divisional applications.

The disclosure was also objected to on the basis of two grammatical and typographical errors. The Examiner is thanked for a careful review of the specification, and these errors have been corrected, as indicated herein.

### **Claim Rejections - 35 U.S.C. § 112**

Claims 10-43, 45-67, 246-253, 260-263, and 278-281 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Specifically, the wording “enabling the user...” in claim 10, line 6, is stated to be indefinite in that it cannot be determined from the language whether the item is ordered, or if the claimed method merely denotes the capability or possibility of the item being order by the user.

The Applicants respectfully traverse this rejection, and argue that the meaning of the phrase “enabling the user...” is in fact clear and that this phrase has ordinary meaning. The Merriam-Webster Dictionary defines the word “enable” as “to provide with the means or opportunity” or “to make possible, practical, or easy.” Accordingly, the phrase “enabling the user to order the item” should be understood to require providing the user with the means, opportunity or capability to order the item, or to make it possible for the user to order the item.

Further, it should be noted that claim 10 does not require that the user actually place an order, but merely that the user is enabled to order. Accordingly, it should be understood that claim 10 does not specifically require any action by the user, but merely that it be made possible for the user to order the item.

Claims 10-43, 45-67, 246-253, 260-263, and 278-281 also stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention since the phrase “showing and/or describing

an item...” cannot be determined. Specifically, the Office Action states that, from the phrase “showing/or describing an item ...”, it cannot be determined if showing an item and describing an item are both required by the claimed limitation, or if only one of the claimed limitations is required.

In order to address this rejection, the Applicants have amended claim 10 to require “at least one of showing and describing an item to a user via the client.” (Emphasis added). The Applicants believe it is now clear that a minimum of either showing the item or describing the item is required, but that both showing and describing the item is also contemplated by this limitation.

In this regard, the Applicants specifically wish to avoid the construction of the term “or” that was recently applied by the U.S. Court of Appeals for the Federal Circuit “*Kustom Signals, Inc. v. Applied Concepts, Inc., Fed. Cir., No. 99-1564, 9/5/01*”. Specifically, in the Kustom Signals case, the term “or” was construed to mean a choice of either signal, but not both. The Applicants believe the amended wording of claim 10 makes it clear that the intended construction of the words “at least one of...and...” should mean “one or another or both”.

Claim 28, as unamended, included a limitation of “to show/or describe”. Claim 28 has similarly been amended to now require providing a client with information “to at least one of show and describe.” For the same reasons presented above with respect to claim 1, this phrase should be construed inclusively to mean “one or another or both.”

Amendments to the phrases “showing and/or describing” and “to show and/or describe” have been to the other independent claim including these phrases.

Claims 28-37, 58-67, 248, 249, 252, and 253 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being incomplete for omitting essential elements, such omission

amounting to a gap between the elements. The identified omitted elements are “ordering the item.”

As correctly noted, a number of claims of the present application are directed to facilitating ordering of an item. As such, the claims are directed to actions that, in one embodiment, may be performed by a machine (e.g., a set top box (STB), personal computer (PC), cell phone or other device capable of executing software instructions) and not the actions that may be performed by a user. In one exemplary use scenario, it is envisioned that the actual ordering may be a user action.

In short, a number of the claims are directed towards methods and systems of facilitating ordering, as opposed to methods and systems for ordering. Accordingly, the actual ordering of the item cannot be regarded as an omitted element.

Claim 62 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particular point out and distinctly claim the subject matter which the Applicants regard as the invention. The Examiner correctly notes that the Applicants inadvertently deleted the dependency of claim 62. The Examiner has further more correctly assumed that claim 62 is dependent on claim 60. The Applicants have, as indicated herein, accordingly amended claim 62 to indicate its dependence on claim 60.

Having made the amendments herein, and having submitted the above remarks, the Applicants believe that the claim rejections under 35 U.S.C. § 112 have been addressed, and withdrawal of these rejections is respectfully requested.

#### **Claim Rejections - 35 U.S.C. § 102**

Claims 10, 12, 15, 16, 21-26, 28, 33-36, 38, 40, 43, 51-54, 58, 60, 63-66, 260, 262, 263, 278, 279, 280, and 281 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by

U.S. Patent No. 5,621,456 (hereinafter Florin). The Applicants respectfully traverse this rejection for the reasons set out below.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Considering claim 1, this claim includes the following limitations:

*"[E]nabling the user to order the item by a single interaction with the client; and in response to the single interaction with the client, causing an order for the item to be placed."* (Emphasis Added).

In rejecting claim 10, the Office Action identifies disclosures in Figures 45-50, and column 24, lines 39-53 of Florin as being anticipatory of the above limitations of claim 10.

While the Applicants agree that Florin discloses an order icon (409), clearly the user discussed in Florin is not enabled to order an item by a single interaction. Specifically, Florin discloses the following:<sup>1</sup>

*[T]o order the mini-espresso machine...the user depresses the select button 155 (or the right arrow button 150) to highlight the order icon 490. As illustrated in FIG. 49, the personal identification order number window 420 is displayed in which the user (using the numeric keypad 176) inputs a personal identification number (PIN). After entering the personal identification number (PIN), the ok button 178 or select button 155 is depressed in order to order the product.*

The methodology for ordering disclosed in Florin accordingly requires multiple interactions by the user with the main module 62, namely:

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<sup>1</sup> Florin, column 24, lines 40-47.

- 1) user depression of the select button 155 (or the right arrow button 150) to highlight the order icon 490;
- 2) user input of a personal identification number (PIN) utilizing the numeric key pad 176; and
- 3) user selection of the ok button 178 (or the select button 155).

Accordingly, to order the mini-espresso machine, the user described in Florin performs three distinct interactions with the main module 62 once a decision has been made to order the mini-espresso machine and as part of the order process.

In contrast, the claim 10 of the present application requires that the user be enabled to order an item (e.g., commence and complete an order process) by a single interaction with a client.

In one exemplary embodiment of the present invention, as described in column 8, line 64- column 9, line 2 of the specification for the present application, a single interaction may for example be achieved by combining previously received information related to an item being offered for sale with previously stored information related to a viewer. In this exemplary embodiment of the present invention, the viewer, as an exemplary user, is not prompted manually to input any personal information (e.g., a PIN) as part of an order process, and is thus able to initiate and complete an order process by a single interaction with that client.

In summary, Florin simply fails to disclose enabling a user to order an item by a single interaction with a client, and is thus not anticipatory of claim 10.

All other independent claims of the present application include at least one limitation requiring the enablement of a user to order an item (or an offering) by a single interaction with a client. For the same reasons discussed above with respect to claim 10, Florin cannot be regarded as being anticipatory of these independent claims.

As each and every element of the independent claims of the present application is not found, either expressly or inherently described, in Florin, the Applicants respectfully request withdrawal of the rejections of the independent claims under 35 U.S.C. § 102.

### **Claim Rejections - 35 U.S.C. § 103**

A number of claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin and in view of further references.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

**Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The prior art references when combined (i.e., Florin when combined with various other references as set out in the Office Action) simply do not teach or suggest all claim limitations of the claims rejected under 35 U.S.C. § 103. Specifically, each of these rejected claims is dependent upon an independent claim that is shown above to include a limitation that is not taught or suggested by Florin. Accordingly, the rejection of the various dependent claims under 35 U.S.C. § 103 is addressed by the above remarks that set out how the independent claims of the present application are distinguished over Florin.

Accordingly, the Applicants respectfully request withdrawal of the rejections against the various independent claims under 35 U.S.C. § 103.



Summary


The Applicants have herein addressed all objections and rejections against the specification and claims of the present application, and have requested withdrawal of all such objections and rejections. The Applicants furthermore believe that all claims of the present application are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact André Marais at (408) 947-8200.

Respectfully submitted,

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VERSION OF SPECIFICATION AND CLAIMS WITH MARKINGS:

IN THE CLAIMS:

**Please amend the claims as follows:**

10. (Amended) A method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method [comprising] including:  
at least one of showing and [/or] describing an item to a user via the client;  
enabling the user to order the item by a single interaction with the client; and  
in response to the single interaction with the client, causing an order for the item to be placed.

11. (Amended) The method of claim 10, wherein the single interaction is one of [the] a group including:  
selecting of a single button; and  
pressing of a single button on a TV remote control.

12. (Unamended) The method of claim 10, wherein causing the order to be placed is achieved by using:  
information related to the item; and  
user related personal information.

13. (Amended) The method of claim 12, wherein the personal information includes at least one of [the] a group including a user's name, address, method of payment and payment account number.

14. (Unamended) The method of claim 12, wherein the personal information is stored in memory in the client.

15. (Amended) The method of claim 10, wherein the distributed computing system is an interactive television system and wherein the at least one of showing and [/or] describing of the item is, at least in part, by a television signal.

16. (Unamended) The method of claim 10, wherein the client includes an auxiliary data processor and a client computer.

17. (Unamended) The method of claim 12, wherein the client is associated with at least a set top box, and wherein the personal information is stored at the set top box.

18. (Amended) The method of claim 17, wherein the set top box is in communication with a local computer and associated storage and wherein the method further [comprises] includes:  
the client retrieving information from one or more of the local computer and the associated storage.

19. (Amended) The method of claim 18, wherein the method further [comprises] includes:  
controlling the client by means of the local computer.

20. (Unamended) The method of claim 18, wherein the local computer is part of a local area network.

21. (Amended) The method of claim 10, wherein the system further includes a central processing facility in communication with the server and wherein the method [comprises] includes:

    sending information used in processing the order from the client to the central processing facility.

22. (Amended) The method of claim 10, further [comprising] including:

    sending an order confirmation to the user to confirm the order.

23. (Amended) The method of claim 21, further [comprising] including:

    communicating information between the client and the server via the central processing facility.

24. (Unamended) The method of claim 23, wherein a telephone system acts as the central processing facility.

25. (Amended) The method of claim 10 including receiving at the client data including:

- (c) information to at least one of show and [/or] describe the item via the client; and
- (d) information to enable the user to order the item by the single interaction with the client.

26. (Unamended) The method of claim 25 wherein the data further includes an item identifier to identify the item.

27. (Amended) The method of claim 26 wherein the item identifier includes [any] at least one of a group of identifiers including a code and a command.

28. (Amended) A method of facilitating ordering an item, the method [comprising] including:  
providing with information to at least one of show and [/or] describe an item to a user;  
and  
enabling the user to order the item by a single interaction with [a] the client.

29. (Amended) The method of claim 28, wherein the single interaction [comprises] includes  
[any] at least one of [the] a group including:  
selecting of a single button; and  
pressing of a single button on a TV remote control.

30. (Unamended) The method of claim 28, including receiving the order from the client, the order including:

information related to the item; and

user related personal information.

31. (Amended) The method of claim 30, wherein the personal information [comprises] includes [any] at least one of [the] a group including a user's name, address, method of payment and payment account number.

32. (Unamended) The method of claim 30, including retrieving the personal information from a memory associated with the client.

33. (Unamended) The method of claim 28, including providing the information in the form of a television signal.

34. (Unamended) The method of claim 28 including communicating with a central processing facility and wherein the client sends the order to the central processing facility for receipt via a transceiver.

35. (Unamended) The method of claim 34 wherein a telephone system acts as the central processing facility.

36. (Unamended) The method of claim 28 including providing an order confirmation to the client to confirm the order.

37. (Unamended) The method of claim 248 including multiplexing the provision of the information and the code to the client to thereby generate data for transmission to the client.

38. (Amended) A computer system to order an item, the system [comprising] including:  
a data processing system to at least one of show and [/or] describe an item to a user; and  
a client to enable the user to order the item by a single interaction with the client and, in response to the single interaction, to cause an order for the item to be placed.

39. (Amended) The system of claim 38, wherein the single interaction [comprises] includes  
[any] at least one of [the] a group including:

selecting of a single button; and  
pressing of a single button on a TV remote control.

40. (Unamended) The system of claim 38, wherein the client is to place the order using:  
information related to the item; and  
user related personal information.

41. (Amended) The system of claim 40, wherein the personal information [comprises]  
includes [any] at least one of [the] a group including a user's name, address, method of payment  
and payment account number.

42. (Unamended) The system of claim 40, wherein the personal information is stored in  
memory of the client.

43. (Amended) The system of claim 38, wherein the distributed computing system is an interactive television system and wherein the at least one of showing and [/or] describing of the item by the data processing system is, at least in part, performed utilizing a television signal.

45. (Unamended) The system of claim 38, wherein the client is associated with at least a set top box, and wherein the personal information is stored at the set top box.

46. (Unamended) The system of claim 45, wherein the set top box is in communication with a local computer and associated storage and wherein the client is to retrieve information from one or more of the local computer and the associated storage.

47. (Unamended) The system of claim 46, wherein the local computer controls the client.

48. (Unamended) The system of claim 46, wherein the local computer is part of a local area network.

49. (Unamended) The system of claim 38, including a central processing facility in communication with a server and wherein the client sends information used in processing to the central processing facility.

50. (Unamended) The system of claim 49 wherein the server is to send an order confirmation to the user to confirm the order.



51. (Unamended) The system of claim 49, wherein the central processing facility is to communicate information between the client and the server.

52. (Unamended) The system of claim 51 wherein a telephone system acts as the central processing facility.

53. (Amended) The system of claim 38 including a data receiver to receive data including: information to at least one of show and [/or] describe the item via the client; and information to enable the user to order the item by a single interaction with the client.

54. (Amended) The system of claim 53 wherein the receiver includes an auxiliary data extractor to extract the information to at least one of show and [/or] describe from the data and a packet data extractor to extract the information to enable from the data.

55. (Amended) The system of claim 54 wherein the auxiliary data extractor provides the information to at least one of show and [/or] describe to the data processing system and the packet data extractor provides the information to enable to the client.

56. (Unamended) The system of claim 53 wherein the data further includes an item identifier to identify the item.

57. (Unamended) The system of claim 56 wherein the item identifier includes [any] at least one a group of identifiers including a code and a command.

58. (Amended) A computer system to facilitate ordering an item, the system [comprising]  
including:

a data source to provide a client with information to at least one of show and [/or]  
describe an item to a user; and  
an information source to provide [a] the client with information to enable the user to  
order the item by a single interaction with [a] the client.

59. (Amended) The system of claim 58, wherein the single interaction [comprises] includes  
[any] at least one of the group including:

a selecting of a single button; and  
a pressing of a single button on a TV remote control.

60. (Unamended) The system of claim 58, including a data receiver to receive the order from  
the client, the order including:

information related to the item; and  
user related personal information.

61. (Amended) The system of claim 60, wherein the personal information [comprises]  
includes [any] at least one of [the] a group including a user's name, address, method of payment  
and payment account number.

62. (Amended) The system of claim 60, wherein the code is to retrieve the personal  
information from a memory associated with the client.

63. (Unamended) The system of claim 58, wherein the data source is to provide the information in the form of a television signal.

64. (Unamended) The system of claim 58 including a data transceiver to communicate with a central processing facility and wherein the client sends the order to the central processing facility for receipt via the data transceiver.

65. (Unamended) The system of claim 64 wherein a telephone system acts as the central processing facility.

66. (Unamended) The system of claim 58 wherein the data source is to provide an order confirmation to the client to confirm the order.

67. (Amended) The system of claim 58 including a multiplexer to multiplex the provision of the information to at least one of show and [/or] describe and the information to enable to the client to thereby generate data for transmission to the client.

246. (Unamended) The method of claim 25 wherein the information to enable includes code executable by the client to enable the user to order the item by the single interaction with the client.

247. (Unamended) The method of claim 25 wherein the information to enable includes data to be processed by code executable by the client to enable the user to order the item by the single interaction with the client.

248. (Unamended) The method of claim 28 wherein the enabling includes providing code to enable the user to order the item.

249. (Unamended) The method of claim 28 wherein the enabling includes providing data to be processed by code to enable the user to order the item.

250. (Unamended) The system of claim 53 wherein the information to enable includes code to enable the user to order the item.

251. (Unamended) The system of claim 53 wherein the information to enable includes data to be processed by code to enable the user to order the item.

252. (Unamended) The system of claim 58 wherein the information to enable includes code to be executed by the client to enable the user to order the item.

253. (Unamended) The system of claim 58 wherein the information to enable includes data to be processed by code to enable the user to order the item.

260. (Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitating ordering an item within a distributed computing system including at least one client and at least one server by:

at least one of showing and [/or] describing an item to a user via the client;  
enabling the user to order the item by a single interaction with the client; and  
in response to the single interaction with the client, causing an order for the item to be placed.

261. (Amended) The machine-readable medium of claim 260, wherein the medium [comprises] includes a data stream.

262. (Amended) The machine-readable medium of claim 260, wherein the medium [comprises] includes a mass storage device.

263. (Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitating ordering an item by:  
providing a client with information to at least one of show and [/or] describe an item to a user; and  
enabling the user to order the item by a single interaction with [a] the client.

278. (Amended) A method of facilitating ordering using a distributed computing system including at least one client and at least one server, the method [comprising] including:

at least one of showing and [/or] describing an offering to a user via the client;  
enabling the user to order the offering by a single interaction with the client; and  
in response to the single interaction with the client causing an order related to the offering to be placed.

279. (Amended) A method [comprising] including:

providing a client with information to at least one of show and [/or] describe an offering to a user; and  
enabling the user to order the offering by a single interaction with [a] the client.

280. (Amended) A computer system [comprising] including:

a data processing system to at least one of show and [/or] describe an offering to a user;  
and  
a client to enable the user to order the item by a single interaction with the client and, in response to the single interaction, to cause an order for the offering to be placed.

281. (Amended) A computer system [comprising] including:

a data source to provide a client with information to at least one of show and [/or] describe an offering to a user; and  
an information source to provide [a] the client with information to enable the user to order the offering by a single interaction with [a] the client.